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IN THE

Supreme Court of the United States  
OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.,  
*Petitioner,*

v.

HILTON DAVIS CHEMICAL CO.

ON WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR INFORMATION TECHNOLOGY INDUSTRY  
COUNCIL AND INTEL CORPORATION AS AMICI  
CURIAE IN SUPPORT OF PETITIONER

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**INTEREST OF AMICI CURIAE**

With the consent of the parties, amici curiae the Information Technology Industry Council (ITI) and Intel Corporation (Intel) submit this brief in support of petitioner Warner-Jenkinson Company, Inc.<sup>1</sup> ITI is an association that represents leading United States providers of information technology products and services. Its members employ more than one million people in the United States and have aggregate annual revenues in excess of \$350 billion. ITI's mission

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<sup>1</sup> Letters reflecting written consent of the parties to the submission of this brief have been filed with the Clerk of Court.

includes advocacy of policies that protect intellectual property. Intel, a manufacturer of semiconductors and related products, is a member of ITI.

As providers of information technology products and services, ITI members have acquired substantial patent litigation experience which affords them an impartial vision of the central issue in this case: the role of the doctrine of equivalents in patent infringement litigation. Having faced that issue both as patentee and as accused infringer, ITI members are intimately familiar with the pressing practical need for a clear and correct understanding of a doctrine that has immense significance to inventors, corporate and financial decisionmakers, and counsel who advise them.

The doctrine of equivalents has assumed a pivotal role in delineating a measure of patent protection beyond that specified by the literal words of patent claims. It is, therefore, imperative that the doctrine be defined and implemented to preserve a proper balance between the rights of patentees to the fruits of their inventions and the rights of business rivals to operate outside of literal patent claim language. It is also imperative that the doctrine be given a clear, precise definition to avoid unwarranted transaction costs and litigation. Only then will consumers be assured the optimum benefits of innovation and competition in a free marketplace. If the balance is struck incorrectly -- or is implemented erratically -- innovation, technology and the economy will all suffer. Amici have a vital interest in avoiding that unfortunate result.

#### SUMMARY OF ARGUMENT

The Federal Circuit's current perspective on the doctrine of equivalents is fundamentally wrong -- whether viewed through the eyes of a patentee or through the eyes of an accused infringer. The decision below introduces needless confusion into the substantive standard for applying the doctrine of equivalents. To prevent equivalency determinations from producing random or haphazard results, the governing legal standard must be correctly defined and trial judges must take a more active role in implementing that standard than the bystander role assigned them under the decision below. The splintered views expressed in the multiple opinions of the Federal Circuit in this case fail to provide clear, correct or adequate guidance for future cases.

Under the decision below, uncertainty in the resolution of equivalency questions will frustrate and impede investment decisions by technology companies. The doctrine of equivalents affects a host of significant business decisions, including: whether to launch products into or remove them from commerce; whether or how to alter designs of products, processes, and machines; and whether to seek or grant licenses. Those decisions influence not only enormous financial commitments but also momentous changes in investment directions.

For years prior to the decision below, the function/way/result test previously enunciated by this Court was well settled as the standard for determining equivalency. That function/way/result test can continue to provide a workable framework for equivalency analyses. It is, by a wide margin,

preferable to the formless standard constructed by a majority of the Federal Circuit in this case: a freeform assessment of the “substantiality” of differences between the alleged infringement and what is claimed in the asserted patent. The amorphous analysis mandated by the decision below is exacerbated by the Federal Circuit’s requirement that the *entire* matter of whether there is infringement under the doctrine of equivalents is a fact question to be decided by the jury without clear guidance as to its meaning. See Pet. App. 17a.

By departing from established precedent, the decision below greatly and unnecessarily increases uncertainty in equivalency determinations. Reaffirmation of this Court’s precedent on the substantive standard and guidance on its application by judges and juries is essential. In short, this Court should hold that the tripartite function/way/result test *is* the standard by which the doctrine of equivalents is to be applied. In any particular case, the test for admissibility of evidence should be whether the evidence is relevant to one of the three prongs (function, way or result).

The Court should also specify that the correct allocation of responsibility between judge and jury under the doctrine of equivalents includes the same allocation that exists in cases of literal infringement. First, the trial court should decide, as a matter of law, the parameters of function, way and result applicable in the circumstances of each case; this decision is analogous to the court’s role in ascertaining the meaning of the words in a patent claim. Then, guided by correct instructions, the jury may resolve the factual question whether the allegedly infringing product falls

within those applicable parameters defined by the court. Under this analytical framework and decisionmaking mechanism, the dual objectives of innovation and competition can advance in tandem as intended by the framers of the Constitution and the drafters of the patent law. And they can advance rationally and predictably, based on sound application of policy, not chance.

#### ARGUMENT

##### I. THE DOCTRINE OF EQUIVALENTS SHOULD BE CORRECTLY DEFINED IN ORDER TO FULFILL ITS PIVOTAL ROLE IN PATENT INFRINGEMENT LITIGATION

As a general proposition, infringement is determined by reference to the literal language of patent claims. Those claims are to be well drafted to “particularly point[] out and distinctly” state “the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112 (1994). The claim language serves a vital notice function by differentiating what is foreclosed from what is not. When an accused infringement falls clearly within the claim language, as properly interpreted, liability is established and that ends the inquiry. See *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950). Informed business decisions, in the information technology field as elsewhere, are based on the paramount significance the law attaches to the notice provided by the claim language.

The doctrine of equivalents is an exception (albeit an important one) to the otherwise dispositive

import of the literal language of patent claims. This Court has long recognized that wooden adherence to the confines of literal infringement could pose a genuine risk that an inventor would forfeit the fruits of a meritorious technological advance because of inevitable limitations of language.<sup>2</sup> Therefore, the doctrine of equivalents “temper[s] unsparing logic” otherwise associated with treating the literal claim language as the sole measure of infringement. See *Graver Tank*, 339 U.S. at 608 (quoting *Sanitary Refrig. Co. v. Winters*, 280 U.S. 30, 42 (1929)).

Consistent with this Court’s opinions, the doctrine had devolved to a well-established standard: measurement of the identity between what is claimed and what allegedly infringes under a tripartite test that focuses on substantial identity of function, way and result. When what is claimed and what is accused perform substantially the same function in substantially the same way to accomplish substantially the same result, the law treats them as the same even though

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<sup>2</sup> Inventions are conceptual and not merely physical embodiments amenable to determination of precise physical boundaries or verbal description. “Conception is the touchstone of inventorship, the completion of the mental part of invention.” *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1227-28 (Fed. Cir. 1994), cert. denied, 116 S. Ct. 771 (1996). And words are at best imperfect tools for communicating concepts. “A word is not a crystal, transparent and unchanged, it is the skin of a living thought and may vary greatly in color and content according to the circumstances and the time in which it is used.” *Towne v. Eisner*, 245 U.S. 418, 425 (1918) (Holmes, J.) Furthermore, “[t]he lucidity of a claim is determined in light of what ideas it is trying to convey. Only by knowing the idea, can one decide how much shadow encumbers the reality.” *Autogiro Co. of America v. United States*, 384 F.2d 391, 396 (Ct. Cl. 1967).

they differ in name, form or shape. *Graver Tank*, 339 U.S. at 608; *Sanitary Refrig.*, 280 U.S. at 42; *Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877). The longevity and stability of that test is attributable to its reliance on familiar and objective considerations. When coupled with adequate guidance to the fact finder in applying this standard to a particular dispute, the function/way/result test provides an indispensable level of certainty and predictability to both patentholders and their competitors when they make investment and marketing assessments of the scope of patents.

That predictability was impaired in multiple ways by the decision below. First, the Federal Circuit announced that the tripartite function/way/result test is no longer the measure of equivalency. Instead, the Federal Circuit adopted a different and less stable test.

Under the decision below, the tripartite test has been subsumed into or replaced by an amorphous inquiry that asks, with no analytical point of focus, whether or not the differences between the patent claim and the alleged infringement are “substantial.” The role of the traditional tripartite test within this undefined analytical matrix is far from clear. No longer the established standard for measuring equivalency, the function/way/result formula may be all or part of the “substantiality” determination. Pet. App. 10a. Exactly how much a part of that determination is at best vague and is not articulated with either clarity or precision in the decision below. That lack of guidance has already been reflected in subsequent decisions of the Federal Court. For example, a panel of that court recently treated the formless “substantiality” analysis as having so marginalized the old test that an

undisturbed finding of triple identity (which previously would have been dispositive on the issue of infringement) was trumped by evidence that the accused infringer intended to design around the patent -- thereby making the product of that design effort a noninfringement. See *Roton Barrier, Inc. v. The Stanley Works*, 37 U.S.P.Q.2d (BNA) 1816, 1827 (Fed. Cir. 1996) (applying *Hilton Davis*).<sup>3</sup>

Moreover, in concluding that identity in function/way/result might not be sufficient to establish equivalency, the decision below fails to offer any clear explanation of what *is* to be the standard for proving infringement under the doctrine of equivalents. The elements of the tripartite test are apparently now to be balanced in some nebulous way against other evidence supposedly bearing on the "substantiality" of the differences. But the Federal Circuit has provided no guidance on how to proceed. Litigants and lower courts have been handed a puzzle: how to construct, calibrate and decipher the balancing scales. See Pet. App. 10a. Increased uncertainty is the inevitable consequence.

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A further aspect of the decision below that will also spawn greater uncertainty is the diminished role of the trial judge. This Court's precedents envision and

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<sup>3</sup> The discussion of the doctrine of equivalents in *Roton Barrier* is rather opaque. Although the Federal Circuit did not expressly overturn the finding of triple identity, some may view the court's analysis as having done so implicitly. In either event, *Roton Barrier* illustrates the quagmire surrounding the tripartite test. Absent a definite vision whether that test is necessary, sufficient, or merely incidental to the issue of infringement, further cryptic decisions like *Roton Barrier* will inevitably follow.

prescribe a significant role for the judge in shaping issues for the fact finder to resolve. According to the Federal Circuit, however, the *entire* question whether there is infringement under the doctrine of equivalents is a fact issue for the jury. Pet. App. 17a. In the view of the Federal Circuit, there are no attendant legal issues within the province of the court. For example, there is no requirement for trial judges to determine or to explain to jurors the substance of the "function," "way," or "result" to be scrutinized in deciding whether differences are "substantial."

Under this regime, juries are destined to be cast adrift on uncharted waters with no maps and no navigational tools.<sup>4</sup> That environment greatly increases the likelihood that infringement under the doctrine of equivalents will be determined on the basis of random

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<sup>4</sup> Whether juries *must* be given the responsibility to apply the legal standard for equivalence to the particular facts is a separate question. Four dissenting judges below suggested that unlike literal applicability of patent claims to accused infringements (uniformly acknowledged to be a jury question), no component whatsoever of equivalency disputes is required to be submitted to juries because the doctrine of equivalents is entirely "equitable." Pet. App. 65a-66a (Plager, J., dissenting). Amici take no position on that matter, except to urge that if equitable discretion is deemed by this Court to be any part of the calculus, the need for more (not less) certainty dictates setting specific limits on its exercise, beyond a general commission to "do equity." See *id.*

and subjective considerations. Effective judicial review of those determinations would be a virtual impossibility.<sup>5</sup> These circumstances, which no business should be forced to face, would be especially injurious to sound investment decisionmaking in the technology industry.

In direct contrast to the decision below, which essentially eliminates whatever certainty and predictability the established tripartite test can afford, prior decisions of this Court reflect a more discerning approach to the doctrine of equivalents. This Court has neither held nor suggested that the triple identity test be abandoned in favor of a formless consideration of substantiality. Equally as important, the decisions of this Court do not relegate trial judges to the role of bystander when equivalency is at issue in jury trials.

Rather, this Court has enunciated and consistently applied the function/way/result test of equivalency.<sup>6</sup> See, e.g., *Winans v. Denmead*, 56 U.S. (15

<sup>5</sup> In dissent, Judge Plager stated that the majority below has come up with a recipe "in which familiar ingredients are to be mixed" differently, but "[t]he mixing is still to be done in the dark, by the multiple hands of a jury under minimal instruction," and those charged with review of the outcome "will remain [ ] blinded." Pet. App. 52a.

<sup>6</sup> It has been suggested that function/way/result is not always an appropriate equivalency test. For example, it might be particularly inapplicable when considering patents on new chemical compounds. See Pet. App. 73a (Lourie, J., dissenting). However, neither that perceived deficiency nor the recognition that determinations of equivalency ought not be a "prisoner of a formula," *Graver Tank*, 339 U.S. at 609, justifies the amorphous "substantiality" test announced by the Federal Circuit. Permitted departures from the function/way/result test should not be freeform; they need to be both justified and subject to defined

How.) 330, 338-44 (1853); *Coupe v. Royer*, 155 U.S. 565, 579-80 (1895); *Sanitary Refrig.*, 280 U.S. at 42-43; *Graver Tank*, 339 U.S. at 608-09. And, in jury trials, this Court has placed squarely on the shoulders of trial judges the obligation to decide (as a matter of law) and to instruct the jury on the appropriate parameters of function, way and result. *Winans*, 56 U.S. (15 How.) at 338; *Coupe*, 155 U.S. at 579-80. When correctly instructed, juries can then apply those parameters to the alleged infringement and thereby determine whether the fact of equivalency has been established.

## II. THE ROLE OF JUDGES IN DETERMINING INFRINGEMENT WHEN EQUIVALENCY IS AT ISSUE PROPERLY PARALLELS THE ROLE OF JUDGES IN CONNECTION WITH LITERAL INFRINGEMENT

### A. Equivalency, Like Literal Infringement, Is A Two-step Inquiry -- One Legal Step And One Factual Step

The correct allocation of responsibility between judge and jury under the doctrine of equivalents should replicate the allocation that exists in literal infringement cases. It is a well-settled proposition that the literal infringement inquiry is a two-step process. First, the court determines what the words of the claim mean -- a

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limits. For example, in chemical compound cases, equivalency can be measured by a well-defined test of substantial similarity of structure and properties (rather than function/way/result). To be found equivalent, accused compounds would have to be structurally similar (e.g., homologs, analogs, isomers) and would have to share substantially similar properties despite relocations or substitutions of substituents, moieties or functional groups.

matter of law. Next, the trier of fact determines whether the words of the claim, as so construed, apply to the allegedly infringing product. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir.) (en banc), cert. granted, 116 S. Ct. 40 (1995). In bench trials, both tasks are performed by the court. In jury trials, only the factfinding role is assigned to the jury.

The inquiry into infringement under the doctrine of equivalents should involve a similar two-step process. First, the court should determine the legal parameters of function/way/result that constrain the assessment of substantial identity. Then, the factfinder must determine whether those delineated parameters apply to the allegedly infringing product. In collapsing this two-step process into a single inquiry that is *entirely* in the hands of the jury, the Federal Circuit departed from this Court's seminal decision in *Winans*. See *Graver Tank*, 339 U.S. at 608.

The patent in *Winans* involved car bodies for transporting coal. Binding of the contents during discharge was a problem the invention sought to solve. The *way* it achieved its objective was to employ a circular car body. The *function* of the circular form was to distribute the load pressure uniformly outward. As a *result*, complete discharge occurred upon removal of the bottom. *Winans*, 56 U.S. (15 How.) at 339 ("by reason of the circular form of the car body, the pressure of the load outwards was equal in every direction," facilitating "the complete discharge of the load through the aperture, when the bottom was removed"). There was no literal infringement in *Winans* because the car body of the allegedly infringing device was octagonal, not circular.

This Court held that the absence of literal infringement did not preclude all further inquiry. Unless "form and substance are inseparable," both "courts and juries" must "look through the form for the substance of the invention;" and where "found, ... it is not a defence, that ... [an infringement] is embodied in a form not described, and in terms claimed by the patentee." *Id.* at 343.

That judicial "look through the form for the substance" is today known as the doctrine of equivalents. From its inception in *Winans*, equivalency was a two-component inquiry, one part law and one part fact. The law question "ascertained what is the structure described, the mode of operation it embodies, and the practical result attained." *Id.* at 340. After that, "the next inquiry is, does the specification of claim[<sup>7</sup>] cover the mode of operation by which this result is effected?" *Id.*

That second inquiry is factual, and it is to be resolved in jury cases only upon instructions from the court that circumscribe the appropriate function/way/result parameters. *Winans* dictates and is wholly compatible with this approach. This Court there addressed first the governing function/way/result parameters, and then described as the jury's sole function the determination whether "in point of fact" the accused car bodies were substantially the same in "the sense above explained." *Id.* at 344. The Court elaborated (*id.* at 344):

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<sup>7</sup> The statute then in force required a patentee to "particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery." Patent Act of 1836, ch. 357, § 6, 5 Stat. 117, 119 (1836).

In our judgment, the only answer that can be given to these questions is, that it must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendant's cars should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree. It must be the same in kind, and effected by the employment of his mode of operation in substance. Whether, in point of fact, the defendant's cars did copy<sup>8</sup> the plaintiff's invention, in the sense above explained, is a question for the jury, and the court below erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative.

The approach this Court employed in *Winans* was jettisoned by the Federal Circuit in the decision below. That departure from precedent cannot be justified or rationalized. It is no explanation to say that amendments to the patent statutes warrant abandonment of the approach employed in *Winans*. This Court reiterated and endorsed the same two-step approach in *Coupe v. Royer*, 155 U.S. 565 (1895), a doctrine of equivalents case decided under a statute enacted after the statute at issue in *Winans*.<sup>9</sup> Moreover,

<sup>8</sup> The word "copy" was used there not in any pejorative sense, but in the sense of "duplicate."

<sup>9</sup> It is unnecessary and perhaps impossible to pin down with any degree of certainty when the complete transition from central to peripheral claiming occurred in our patent system. See Pet. App. 36a n.2 (Newman, J., dissenting). In the final analysis, that

*Coupe* approved the approach set forth in Robinson on Patents, an 1890 Treatise that urged trial judges to "define[] the patented invention as *indicated* by the language of the claims," (not as *limited* by the claims), and for the jury to "judge whether the invention so defined covers" what is accused. 155 U.S. at 579 (emphasis added). In short, the two-step inquiry prescribed in *Winans* was recapitulated.

*Coupe* also adhered to the approach in *Winans* in additional respects. When discussing appropriate jury instructions, this Court specifically referred to "instructions as to the nature and scope of the plaintiff's patent", *id.* at 580, which there meant accounting for the recurring mention of a vertical shaft in the claims *and* for "differences . . . arising out of difference in position," as well as other differences. *Id.* at 576, 580. In other words, a *court* first fixes the parameters of equivalency and only then is the jury to determine "the question of infringement." *Id.* at 579-80. Thus, *Coupe*

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inquiry is not productive because the doctrine of equivalents was part of the system throughout the transition. The outcome in this case should therefore not be mired in an analysis of changes in statutory language and incomplete anecdotal references to prior practices. Under the Act of 1870, the claiming requirement placed on a patentee was that he shall "*particularly point out and distinctly* claim the part, improvement, or combination which he claims as his invention or discovery." Patent Act of 1870, ch. 230, § 26, 16 Stat. 198, 201 (1870) (emphasis added). Notwithstanding the somewhat different language in the prior statute, the doctrine of equivalents survived. The current statute also calls for "*particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (1994) (emphasis added). The inclusion in the current statute of language virtually identical to the 1870 language hardly signals the demise or alteration of the doctrine of equivalents.

confirms that this Court's two-step approach is applicable to determinations of equivalency.

When the pedigree of the two-step law/fact inquiry is properly understood, it is clear that the Federal Circuit has no basis for placing unwarranted reliance on this Court's later statement that "[a] finding of equivalence is a determination of fact." Pet. App. 14a (quoting *Graver Tank*, 339 U.S. at 609). Nothing in *Graver Tank* transforms the trial judge's responsibility to fix the legal parameters of function/way/result into a purely factual inquiry. Indeed, the quoted passage from *Graver* is entirely in accord with *Winans* and *Coupe*, both of which recognize that the *only* question for the jury is whether the evidence shows that the parameters as set by a judge in fact embrace the allegedly infringing product. By failing to adhere to that allocation of responsibility between judge and jury, the Federal Circuit erred.

#### B. Case-Specific Instructions On Function/Way/Result Must Be Required

In a literal infringement case, a jury cannot be expected to determine whether the words of the claim in fact apply to the allegedly infringing product unless correctly instructed on the law. See *Markman*, 522 F.3d at 988-89.<sup>10</sup> Likewise, a jury cannot be expected to

<sup>10</sup> At the time this brief is filed, *Markman* remains *sub judice* and its disposition unknown. In *Markman*, this Court may or may not ultimately decide that, even though the literal meaning of words in the claim is a matter of law, there are some underlying fact issues for the jury. Even if this Court decides in *Markman* that some underlying fact issues must go to the jury, juries would need correct instructions to apply a particular meaning to claim language depending on their finding of particular facts

determine whether the parameters of function/way/result in fact apply to the allegedly infringing product unless correctly instructed on the law defining those parameters. The trial judge needs to lay out for the jury the substance of the function/way/result parameters that may lawfully be scrutinized.

Judge Plager's dissenting opinion below makes a compelling case that trial judges must be required to give such case-specific instructions on equivalency; and that, in the absence of correct instructions, equivalency determinations will be both uncontrolled and unreviewable. The dissent observed (Pet. App. 54a-55a):

- "Federal district judges, perhaps understandably, by and large make little pretense of liking these patent infringement cases, and are quite content to give them, and all the issues in them, to juries to decide."
- "The cases typically come ... on appeal with nothing more than a general verdict finding infringement. There is no explanation by the jury of the rationale behind their verdict, if any exists."
- "[Appellate] review ... assume[s] that the jury understood the technology, understood the law

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commended to them for resolution. Likewise, in some equivalency cases, when the legal determination of the appropriate function/way/result parameters depends on underlying factual disputes, juries should be instructed to apply particular parameters depending on their finding of particular facts commended to them for resolution.

of patents and the policies that underlie it, understood the function, way, and result of the matter, and arrived at a considered decision."

- "It is enough to sustain a jury verdict of infringement by equivalents if the trial court's instructions are without prejudicial error (oftentimes this translates into the less said the better), and if there is any substantial evidence in the record which the hypothetical reasonable juror could have believed, and so believing, arrived at the verdict."
- "A plaintiff must have a virtually impossible case, or incompetent counsel, to fail to have something in the record which can be argued is substantial enough ...."
- "[T]he reality is that the doctrine of equivalents is a virtually uncontrolled and unreviewable license to juries to find infringement if they so choose."

That untoward result should be foreclosed as it will contribute neither to certainty nor to the progress of the useful arts, which is the constitutional basis of the patent system. U.S. CONST. art. I, § 8, cl. 8.

What *will* contribute both to the useful arts and to necessary certainty in infringement cases is a return to the equivalency determinations mandated by this Court in *Winans* and *Coupe*. When assigning to the jury the role of determining whether an accused infringer used a patentee's invention "in the sense above explained," this Court in *Winans* clearly called for an explanation to the jury of the specific function/way/result parameters to be considered by

them. 56 U.S. (15 How.) at 344. When requiring the submission of an equivalency question to the jury "with proper instructions as to the nature and scope of the plaintiff's patent as hereinbefore defined," 155 U.S. at 580, this Court in *Coupe* was likewise calling for an explanation to the jury of the specific function/way/result parameters to be considered by them.

Before that approach was abandoned in the decision below, other Federal Circuit decisions more closely followed this Court's precedent. In *Lear Siegler, Inc. v. Sealy Mattress Co.*, 873 F.2d 1422 (Fed. Cir. 1989), a jury had found that the patent-in-suit was infringed under the doctrine of equivalents. The court of appeals reversed because the plaintiff had not produced evidence at trial showing the function, way and result of the invention and the accused products. As the court explained (*id.* at 1425-1426):

[a]bsent the proper *Graver Tank* context, i.e., a showing of how plaintiff compares the function, means, and result of its claimed invention with those of the accused device, a jury is more or less put to sea without guiding charts when called upon to determine an infringement under the doctrine. While we do not doubt the ability of a jury to decide the factual issue of equivalence, to enable the jury to use its ability, ... the three *Graver Tank* elements must be presented in the form of particularized testimony and linking argument.

The court expanded on its ruling (*id.* at 1427) by stating:

[I]f a jury is to rationally find all three elements of equivalence, it must be told what evidence establishes the equivalence of the claimed and accused devices as to each element. Otherwise, there is too much risk [and] the jury will simply compare the two inventions as to overall similarity, in violation of *Graver Tank*.

Plainly, the court recognized the importance of fully informing juries on the pertinent function/way/result of both the claimed invention and the accused product before they could determine equivalency.

The Federal Circuit reiterated that theme in *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320 (Fed. Cir. 1991), cert. denied, 504 U.S. 974 (1992). There, a jury had found the patent-in-suit to be infringed by reason of equivalency. The Federal Circuit affirmed the entry of judgment notwithstanding the verdict, stating that "what is clearly lacking in that testimony is a sufficient explanation of both why the overall function, way, and result of the accused device are substantially the same as those of the claimed device and why the plastic/slotted, plastic/felt arrangement is the equivalent of the claimed buttons limitation." *Id.* at 1327. Thus, in *Malta*, the Federal Circuit also had a clear understanding that infringement under the doctrine of equivalents could not be determined by juries in the absence of a particularized explanation of the proper function/way/result parameters to be considered.

In both *Lear Siegler* and *Malta*, the Federal Circuit "signalled the need for a more disciplined analysis in"

jury trials of equivalency cases. Pet. App. 68a n.8 (Plager, J., dissenting). Yet, despite these prior signals, and despite this Court's precedent which points to a requirement for case-specific instructions by trial judges on the parameters of the three prongs of the tripartite test, and despite the adverse impact on reliability, the Federal Circuit has opted to send the entirety of all equivalency questions to juries with virtually no guidance.

In the information technology field as elsewhere, the reliability of legal advice on equivalency questions can be only as good as the system for resolving doctrine of equivalents disputes. This Court previously established a system that tends to enhance such reliability by dividing the equivalency issue into legal and factual components, and by providing for case-specific jury instructions on the legally applicable function/way/result parameters before the factual component is submitted to juries. That satisfactory approach is well-established and offers stability. It has not been altered by Congress and the decision below offers no legal or practical justification for its departure. The Federal Circuit's rejection of that established approach should be reversed.

### **III. AN AMORPHOUS, SEPARATE TEST FOR INSUBSTANTIALITY OF DIFFERENCES IS NEITHER REQUIRED NOR APPROPRIATE**

#### **A. The Amorphous Substantiality Test Was Not Mandated By This Court In *Graver***

The decision below further undermines certainty and predictability by abandoning the dispositive role of

the tripartite test without providing a coherent replacement. Prior to the Federal Circuit's *en banc* decision in this case, inventors, corporate and financial decisionmakers and their counsel could base assessments on the scope of patent protection on the tripartite function/way/result test. That test was firmly established and long recognized as the sole standard for the patent protection afforded by the doctrine of equivalents. After the decision below, it is far from clear what role the function/way/result inquiry now plays. Equally unclear are the parameters and standards of the newly-created inquiry.

The Federal Circuit's erroneous departure from precedent is plainly revealed in its opinion. At its core, the error in the decision below derives from a misreading of *Graver Tank*'s comment that the substitution of manganese for magnesium was an insubstantial change "under the circumstances." See *Graver Tank*, 339 U.S. at 610. The Federal Circuit transformed that comment into the launching pad for a separate, wholly new and altogether amorphous test of "substantiality." Pet. App. 7a-8a. According to the Federal Circuit's reading of *Graver Tank*:

The Court defined the doctrine of equivalents in terms of the substantiality of the differences between the claimed and accused products or processes. The Supreme Court in *Graver Tank* thus made insubstantial differences the necessary predicate for infringement under the doctrine of equivalents.

*Id.* at 8a. But the Federal Circuit paid no attention to this Court's specific reference in *Graver Tank* to the "circumstances" of that case. See 339 U.S. at 609. Nor

did the court of appeals advert to the earlier discussion in *Graver Tank* of those very circumstances in the context of a function/way/result analysis of equivalency. Those omissions are significant. When *Graver Tank* is correctly read in its entirety, with those omissions restored, there is no room to doubt that this Court required substantiality to be measured by the tripartite test. *See id.* at 608-609.

*Graver Tank* focused directly on the tripartite test. *See id.* at 608. It was precisely in connection with that very test that the Court referred to "the wholesome realism" of the doctrine of equivalents. *Id.* This Court also concentrated on the established tripartite test in analyzing the particular equivalency issues involved in *Graver Tank*. *See id.* at 610. Similarly, the Court evaluated "insubstantial change" in the context of function/way/result, not separately and not as an umbrella test. *See id.* at 610-11. All evidence the Court suggested as relevant to weighing substantiality bore directly on the tripartite test. *See id.* at 609-11.

It is, therefore, not surprising that the Federal Circuit found and cited no direct support in *Graver Tank* for a separate, umbrella test for weighing the substantiality of differences between the patented and accused products. The standard conjured up in the decision below has no roots in *Graver Tank*. *Graver Tank* was all about satisfaction of the triple test – no more, no less.

**B. An Amorphous, Separate Insubstantiality Test That Contributes To Confusion and Uncertainty Is The Legacy Of The Federal Circuit's Incorrect View Of The Doctrine of Equivalents**

The decision below also shrouds in mystery the continuing status of the function/way/result test in the new "substantiality" inquiry. The first question set forth in the Federal Circuit's opinion was whether something more than satisfaction of the tripartite test is required to prove equivalency. Pet. App. 5a. But the only answer the Federal Circuit could muster was "maybe" *id.* at 17a -- leaving considerable confusion in its wake.

For example, a panel of the Federal Circuit has already applied *Hilton Davis* to reverse an equivalency determination where the district court found that the tripartite identity test was met and where that finding was left undisturbed on appeal. See *Roton Barrier, Inc. v. The Stanley Works*, 37 U.S.P.Q.2d (BNA) at 1827-28. The stated basis for the Federal Circuit's decision in *Roton* was evidence that the alleged infringer intended to design around the patent. *Id.* at 1827 Relying on the proposition from *Hilton Davis* that such evidence can support an inference of substantiality of difference, the Federal Circuit proceeded to draw that inference *on appeal* even though no such inference had been drawn by the finder of fact in the district court. *Id.* In short, the court of appeals in *Roton* viewed the substantiality of differences between what was claimed and what was accused to be an established fact -- notwithstanding the trial findings of insubstantial differences in function, way, and result.

Adding to the confusion, a concurring opinion in *Roton* offered a further novel basis for the judgment. The concurring opinion observed that the accused infringer had a patent of its own, and elevated that patent to the status of controlling evidence of substantiality of the differences between what was claimed by plaintiff and what was being done by the defendant. *Id.* at 1828 (Nies, J., concurring).<sup>11</sup> Not only is that conclusion contrary to this Court's holding in *Sanitary Refrig. Co. v. Winters*, 280 U.S. 30, 43 (1929),<sup>12</sup> but it also places the Patent and Trademark Office, not a trial judge and not a jury, in the pivotal position of decisionmaker on the question of substantiality.<sup>13</sup>

Neither the opinions below in this case nor the more recent opinions in *Roton* clearly delineate the factors of the amorphous "substantiality" test, the limits (if any) of those factors, or how such factors are to be applied. Equally as important, the Federal Circuit has failed to explain where the function/way/result test (the standard amenable to analysis at the time business decisions are made) now stands. There is no way of

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<sup>11</sup> This same view was expressed in a later Federal Circuit panel decision. See *Zygo Corp. v. Wyko Corp.*, No. 94-1445, 1996 U.S. App. LEXIS 5614, at \*20 - \*21 (Fed. Cir. Mar. 26, 1996).

<sup>12</sup> In *Sanitary Refrigerator*, where the tripartite test was factually met, this Court held that factual finding to be "controlling", and infringement could not be avoided "by any presumptive validity that may attach" to the accused infringer's own patent. 280 U.S. at 43.

<sup>13</sup> That approach will end up yielding protracted sideshows over validity of an accused infringer's patent. Failure to produce such a sideshow would be at the risk that *ex parte* Patent and Trademark Office rulings in which one litigant had no participation will control the outcome of the litigation.

knowing when other so-called evidence of substantiality or insubstantiality will or will not trump evidence that in the past would have been dispositive under the function/way/result test. Decisionmakers in industry and finance are now without judicial guidance on how such “other evidence” may be weighed against the function/way/result test. When business decisions made in this vacuum are tested in court, the litigants, judges and juries will lack objective and predictable criteria for resolving the confusion.

For example, the decision below notes that evidence of “copying” can support an inference that differences are “insubstantial” but evidence of “designing around” can support an inference that the same differences are “substantial.” Pet. App. 11a, 12a, 13a. The critical flaw of this formulation is that “copying” is not necessarily distinguishable from “designing around.” These activities exist on a spectrum where their separation “is often a matter of degree.” Pet. App. 76a (Lourie, J., dissenting). “Both involve focusing on the patented invention,” and discerning copying from designing around depends “upon whether one succeeds or not in getting far enough away from the claims .... Both ... attempt to make as little change ... as possible to retain or improve on the properties of the invention, while avoiding infringement.” *Id.*

It is, therefore, futile to expect that a jury will accurately analyze the copying/designing-around spectrum if the court fails to provide spectrograph equipment. It is also incorrect to assume that the choice between “copying” and “designing around” is an all or nothing proposition. An alleged infringer might “copy” a *result*, while intentionally “designing around”

the *way* it is accomplished. Similarly, it is also wrong to assume (as does the majority below) that independent development is necessarily relevant *only* to rebut charges of copying. See Pet. App. 11a-14a. In his dissenting opinion, Judge Lourie aptly observed that “[d]istance from ... a patent ... and the history and purpose of one’s product development ... are ... not synonymous ....” *Id.* at 76a.

Whether, when and how factors such as “copying,” “designing around,” or “independent development” should be considered in resolving equivalency disputes is clearly problematic.<sup>14</sup> The lack of guidance can only spawn further uncertainty and instability.

In order to restore stability and enhance certainty in the application of the doctrine of equivalents, this Court should reverse and rectify at least two crucial errors in the Federal Circuit’s *en banc* decision in this case. First, the amorphous “substantiality” test should be rejected and the function/way/result test previously adopted by this Court should be reinstated. Next, this Court should explain with clarity and precision what “other evidence” of “substantiality” or “insubstantiality” may be considered, and clarify that such evidence is considered only when it can be shown to be logically

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<sup>14</sup> This brief takes no position on such questions except to urge this Court to decide conclusively whether these factors may be considered in applying the doctrine of equivalents. If the Court holds that these factors are permissible considerations, it should then provide specific guidance on when and how these factors are to be weighed in the analysis.

related to one or more of the prongs of the function/way/result test.

#### CONCLUSION

The judgment of the Federal Circuit should be reversed.

Respectfully submitted.

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